Brown, Brian (TM)

From: TMFeedback
Sent: Monday, January 10, 2011 10:56 AM
To: Brown, Brian (TM)
Subject: FW: Small Business Study -More info

From: Volkoo (b)(6)
Sent: Saturday, January 08, 2011 2:13 AM
To: TMFeedback
Subject: Small Business Study -More info

The following is an addendum to a submission sent a short time ago.

An additional tactic employed by the outside TM counsel of Nokia was to threaten to petition to cancel our trademark 3026855 if we continue to oppose their pending application 79076349. This unfounded threat was made recently by their outside TM counsel in a letter they sent us on December 7, 2010.

We are a smaller company with 1000's of customers nationwide, we have 6 pending or already registered TM's. It has been a pleasure to deal with the great staff at the USPTO. The US trademark office staff has been very friendly helpful, informative, and cool.

The following is a good suggestion to improve efficiency and help smaller businesses protect their trademarks, while hopefully avoiding the expenses involved with TTAB proceedings. In the event that a USPTO Trademark application examining attorney may overlook an existing registered mark which has a high likelyhood of creating confusion with the applied mark, the Letter of Protest that can be submitted to the Office of Petitions. The LOP is a good mechanism to protect TM owners from threatening pending marks, as the Petitions office is the first line of defense after the examiner. However if there was a way for the information/argumuments contained in granted letters of protests to be forwarded to examiners assigned to applications, it would increase efficiency. It would be very benificial to existing trademark owners who discover an application for a mark that threatens their mark by likeliehood of confusion. Currently the examiners aren't allowed to
view information in the Letters of Protest. If the examiners were allowed to view information in the Letters of Protest it would help them make a much more informed decision; which in turn helps existing registrants.

Respectfully submitted, thanks,

Jeff Volk
(b)(6)

Brown, Brian (TM)

From: TMFeedback
Sent: Monday, January 10, 2011 10:55 AM
To: Brown, Brian (TM)
Subject: FW: Small Business Study

From: Volkoo [(b)(6)]
Sent: Friday, January 07, 2011 11:59 PM
To: TMFeedback
Subject: Small Business Study

Everyone knows that small companies are the backbone of the American economy, the folowing is a copy of a recent letter of protest, thank you for looking into TM Bully tactics.

Addendum to 12/22/10 Letter Of Protest
RE: USPTO Application: 79076349, likelihood of confusion with 3026855
The following addendum is for the 12/22/10 filed Letter of Protest
It is respectfully requested that the USPTO Office of Petitions refuse application79076349 XpressRadio under section 2(d) likelihood of confusion with registered mark3026855 eXpress. Please consider the following supporting information.
Additionally, most of the goods listed in the pending application for mark (XpressRadio), application 79076349 are the same existing registered the mark (eXpress) registration3026855, also the type of trade channels are very similar for the goods, cell phone stores.
After I reviewed the 07/02/10 response to office action by the attorney for Nokia for their application 79076349, I noticed that the applicant Nokia listed two prior registrations, which are derivatives of Express. It then came to the attention of Express that Nokia has already been able to "sneak through", so to speak two other diluting marks likely to cause confusion; the marks are (XpressMusic) Reg. 3472545 and mark (Xpress-On) Reg. 3627612. Registration3026855 (eXpress) brand of goods includes cellular/wireless phones AKA mobile telephones same as listed in (XpressMusic) Reg. 3472545, (eXpress) brand 3026855 of goods also includes cell phone accessories including housings AKA covers, same as listed in (Xpress-On) Reg. 3627612. Mistakes happen, no system is perfect, and it is apparent that Nokia marks Reg. 3472545and Reg. 3627612 were issued in error, as3026855 was overlooked. Nokia marks Reg.3472545 and Reg. 3627612 marks cause confusion in the marketplace with 30268 55 and should have been refused, we will be petition to have these marks cancelled. Approval of mark Reg. 79076349 would only compound an already concerning situation.
Express would like to thank the USPTO Protest office for granting the 07/12/10 LOP, subsequently the examiner refused application 79076349 because of likelihood of confusion with reg. 3026855. However on 10/04/2010 Nokia responded to the examiners refusal with misleading and false information, which wrongly persuaded the examiner who ultimately erroneously approved 79076349. Again, the USPTO examiner assigned to application 79076349was influenced by very misleading information contained in the 10/04/2010 response by Nokia attorneys. Please allow me to clear up the false assertions made by the attorney for the applicant; these misleading assertions which have led to misperceptions by the examiner for application, which led to erroneous approval.
Contrary to one of the false assertions made by the applicant in their response to the office action, the 07/12/10 LOP was not filed to leverage the deal we were attempting to make with them, we were simply protecting our mark from being diluted.
In March of this year, after careful consideration and planning Jeff Volk, the founder of Express (Reg. 3026855) decided that in order for Express brand of products to grow to the next level so to speak, it is going to require the resources of a larger company such as Nokia. Nokia was the first company we reached out to, because Nokia is one of the best manufacturers of phones and accessories. We also picked Nokia to be the first company to reach out to try and team up with, because we had recently become aware of their pending application 79076349XpressRadio. So in March of this year, we decided try to work out an amicable agreement rather than immediately protesting their pending XpressRadio application. We were

attempting to join them instead of trying to beat them, however the Nokia outside counsel for Nokia said Nokia was not interested in Express, he claimed they have their own Xpress. We were forced to file the 07/12/10 letter of protest in order to protect our Express mark.

The attorney for the applicant cited several non-applicable cases: *In re National Data Corp.*, 224 U.S.P.Q. 749, 750 (Fed. Cir. 1985); *Opryland USA Inc. v. Great American Music Show, Inc.*, 23 U.S.P.Q.2d 1471, 1473 (Fed. Cir. 1992). -In some cases, when evaluating confusion, the marks are not to be dissected but rather are to be compared in their entireties. In the case of comparing eXpress to XpressRadio, it is apparent that most consumers would think that XpressRadio is affiliated with the eXpress. As previously stated, our investigations show that XpressMusic has not been used in years, and is virtually unknown, Xpress-On is also unknown by most people, so Nokia cannot make the superior usage claim. Our investigations show that Nokia has been capitalizing the X on Xpress, and the M on Music, the O on -On. In the technique Nokia used to sway the examiner of their XpressRadio word mark application, the applicant purposely spelled XPRESSRADIO all in caps to try and make it look less similar to EXPRESS. The capitalization makes a difference, according to the way in which Nokia has used Xpress; XpressRadio would be confused and eXpress Reg. 3026855. The Nokia proposed mark XpressRadio mark looks related to eXpress. Express 3026855 is a word mark, some of our product have logos with eXpress, and Express, it is still express. It would set a bad precedent for Nokia or any other company to be able to just add a word or symbol to a mark to dilute it before going in for the root mark, eXpress 3026855 is the root mark.
The following hypothetical examples are parallel to what Nokia has done: it would cause confusion in the marketplace and be unfair to Express clothing co. if Guess co. were to register and use XpressPants, Xpress-On, & XpresssShirts. What pants and shirts are to clothing, music and radio is to phones, and our phone face plates are always On.
It would be unfair to Apple company with the registered mark iPhone, if Nokia company were to be allowed to register a mark called iPhoneRadio. It would be unfair to RIM company with the registered mark Blackberry, if Nokia were to be allowed to register BlackberryRadio. It would not be fair to Progressive insurance company if State Farm insurance were to be allowed to register State Progressive.
In the event an that a TM application for the hypothetical mark VirginRadio it would cause confusion for the company Virgin Mobile, it would likely be refused for likelihood of confusion. It would create confusion in the marketplace and be unfair to Samsung with their Galaxy brand if Nokia were to produce GalaxyMusic, Galaxy-On, GalaxyRadio what would be next, Alaxy.
Again, contrary to the false assertions made in the letter by the attorney for the applicant, again, I think that most people actually would say that eXpress is very similar to Xpress; both phonetically and in appearance, especially when heard in a radio commercial. Adding Music, -On, or Radio to Express does not change the impression, it still says eXpress, eXpress stands out -Numerous trademark attorneys, & USPTO personnel agree. If people hear one of the testimonials in our commercials stating that -go see the latest model of eXpress phones and accessories, they would be confused if they heard a commercial by Nokia stating -go see the new XpressRadio phone and accessories, there is an extremely high probability of confusion. The cases listed in the applicants response are not applicable to this case -Confusion is ultimately to be decided on the basis of whether there is confusion as to source of origin of the goods/services. *See Globe-Union Inc. v. Raben Laboratories Inc.*, 180 U.S.P.Q. 469 (T.T.A.B.1973)
The counsel for the applicant also made a point of the fact that T-Mobile is shown in some of our marketing materials from when our application was submitted in 03/31/04; that's because T-Mobile was hot at the time and was one the other popular brands we have sold over the years, in addition to our eXpress brand. Express is not laudatory in nature. Moreover, Express brand is not meant to designate quick service as a T-Mobile retailer.
Nokia attorney cited another irrelevant case: The Trademark Trial and Appeal Board has considered third party registrations to be probative in determining whether a term is common to a particular industry. *See In re Dayco Products Eaglemotive Inc.*, 9 U.S.P.Q.2d 1910, 1911 (T.T.A.B. 1988) (relying on third party registrations as probative to show weakness of term IMPERIAL in the tire industry); *see also In re E.I. duPont de Nemours & Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973) (considering the coexistence of other similar marks used on similar goods to evaluate the likelihood of confusion). Express is not a common term used in the mobile phone business, it is just not true, there are very few marks derived from Express for class 009. In an additional effort by Nokia counsel to deceive the examiner, Nokia listed other marks from other classes, which are not pertinent. And the attorney for the applicant listed several marks which do not have cell phones and access ories listed in their goods. The mark IC 009 Xpress Reg. 3268696 is for car stereo audio video parts company, they do not list phones; Xpress Reg. 3268696 goods that are not the same as Reg. 3026855 Express. Nokia cited the mark Reg. 3436082 Pocket Express -they make software for phones, not the phones themselves. Pocket Express is virtually unknown in the mobile phone industry.
Reg. 3252212 Express Card is wi-fi cards for computers, not phones. Reg.3722858 Notifyxpress is software for phone voice messages, not the phones themselves. The only IC 009 marks among the marks cited by the applicants counsel which actually list the phones in their goods are the 1B T-Mobile New Express, and the 1B Samsung mark

MultiExpress. The marks that are most diluting to Express 3026855 are the Nokia Xpress marks. It is not true for Nokia counsel to claim that Express a common term in the cell phone industry. Express mark 3026855is still a strong mark, but it will be even stronger when we get done cleaning up the diluting derivates of Express.
Besides the Xpress marks of the applicant, the only other diluting marks cited in the 10/04/2010 response by Nokia attorneys, are 1B marks Multiexpress and T-Mobile New Express. Express is now aware of the cited 1B intent to use class 009 (Multiexpress) mark of Samsung and the class 009 (T-Mobile New Express) mark of T-Mobile, which technically shouldn't of been registered because of likelyhood of confusion with Reg. 3026855, those marks also appear to be deliberate attempts to dilute, before going in for the kill; we will petition to cancel these marks as well. Contrary to another false assertion by Nokia; most trademark specialists agree that generic word marks which also happen to be words are entitled the same protection as are very unique marks. Marks such as Guess, Virgin, Atlantic, Progressive, Strive, Galaxy, all deserve equal protection. There are more than 180 Express trademarks pending or registered for various goods, everything from popcorn makers to medical devices.
Again, It would set a bad precedent if Nokia or any other company to be able to just add a word or symbol to a mark to dilute it before going in for the root mark. Smaller companies would be discouraged from applying for trademarks if bigger companies such as Nokia can easily swallow up smaller companies brands. The old -dilute, then try & go in for the kill technique, used the Nokia outside counsel is tantamount to trademark bullying. The petitions department of the USPTO is the first line of defense for trademark owners, and now that the Trademark Bully Act is in the spotlight, the petitions department has even more power to protect the marks of smaller companies from the trademark bullying of bigger companies, who attempt to circumvent the fair process of intellectual property acquisitions.
The 10/04/10 response to the refusal is reminiscent of an unsuccessful desperate attempts by T-Mobile company to register Express in association with cell phone products for USPTO IC Code 009 . Please see USPTO examining attorney office actions and refusals in USPTO applications for application serial number 77491117. TheUSPTO examining attorney office made final refusals of the applications by T-Mobile for IC classes 009 soley because of likelyhood of confusion with the mark of Express 3026855.
When T-Mobile filed the intent to use application for everything under the sun including cellular phones, I don't think they were really going to make a phone called T-Mobile News Express, probably not. Two years after their T-Mobile News Express was registered, T-Mobile tried to go in for the kill and get the Express brand for class 009, with their application serial number 77491117Express, which was rightfully refused.

It was not until the last couple of years that name models for phones has become the trend. 5 years ago the only Nokia name model phone was the N-Gage, most phones were number models like 6800 & 6610. 5 years ago Motorola had only the Razr as their only name model phone, prior to that it was in the 90s they had the Star-Tac, & Micro-tac. Prior to a couple of years ago HTC, Samsung, Sony-Ericsson, & Siemens didn't have any name brand model phones, their models were all alpha numeric brands like V205 & T68, Handspring Treo, HP IPAQ.
Does Nokia condone trademark bullying, I have been cool to Nokia, I expected the same in return, I prefer diplomacy. There was an article in the NY Times a couple of months ago that talked about complacency at Nokia. It's astonishing how this matter has been dealt with, I'm a very reasonable person, If the counsel for Nokia has recommended that Nokia battle this out, because it is cheaper than making a fair deal, then he has done Nokia a diss-service. The old saying -know when to choose your battles, is very applicable in this case. I would of liked to of had a better understanding/relationship with Nokia by now. Intellectual properties including trademarks have a value, and we are not going to let Nokia steal our mark.
From humble beginnings eXpress is enjoying close to two decades sales of Express (3026855) brand of communications products nationwide. eXpress products have been selling at street-fairs and college campuses as well as retail stores, distributors and the Internet. We have enjoyed much word of mouth adverting as well from our many happy customers, as well as commercial testimonials from numerous celebrities, musicians, & pro-athletes. Express U.S. Registered trademark is now more than 5 years old. Express is pleased to have received trademark protection granted in 2005. It is surprising that Nokia could have the audacity to apply for this 3rd derivative mark of Express brand, again, it is blatantly obvious that Nokia is attempting to dilute the mark Express 3026855. What will they try next, if Nokia were to be allowed to register XpressRadio, it would not be surprising to see them try to go for the kill so to speak and try to register XpressPhone. Some companies think t hey can sail through the sea of trademarks and commandeer any mark they see fit for themselves, the step-aside approach is not going to work on us. Nokia should pick someone else to pick on and another name to run with instead of trying to steal the eXpress brand from us. As previously stated negotiations for an amicable agreement between Express and Nokia have failed do to the wrong perception held by Nokia outside trademark counsel. eXpress is in the midst of formalizing an agreement between another large manufacturer of phones who is going to work with our team to produce the next generation of eXpress phone products.
Please consider refusing application79076349.

Respectfully submitted,
Jeff Volk
(b)(6)